UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL R. BLOOMBERG, JOHN D. WAANDERS, and HELMARS E. OZOLINS

Appeal 2007-0151
Application 10/081,132
Technology Center 2600

Decided: March 14, 2007[1]

Before JAMES D. THOMAS, MAHSHID D. SAADAT, and JEAN R. HOMERE, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-12, which are all of the claims pending in this application.

We affirm.

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[1] An oral hearing for this appeal was held February 8, 2007.

BACKGROUND

Appellants' invention relates to the biometric enablement of computer terminals using finger-image sensing and authentication. According to Appellants, a finger-image sensor biometrically identifies a person who is seeking to access or participate in network functions including voice communication and other network-related functions (Specification 2). An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

> 1. A system for enabling use of a computer terminal in a network to access or otherwise participate in at least one network-related function and voice communication over the network, comprising:
>
> A telephone handset including a microphone and a speaker coupled to provide signals to and receive signals from the computer terminal for voice communication;
>
> A finger-image sensor coupled at least to provide signals to the computer terminal relating to a finger-image sensed by the finger-image sensor;
>
> means for electronically authenticating a finger-image sensed by a finger-image sensor based on the finger-image-related signals provided to that computer terminal;
>
> means responsive to the authenticating means for enabling the computer terminal in the network to access or otherwise participate in the performance of at least one network-related function and voice communication over the network at least from each computer terminal for which a sensed finger-image was authenticated.

The Examiner relies on the following prior art references:

Chang	US 2002/0122415A1	Sep. 5, 2002 (filed Mar. 1, 2001)
Patel	US 2002/0174345 A1	Nov. 21, 2002 (filed May 17, 2001)
Olshansky	US 6,493,437 B1	Dec. 10, 2002 (filed Apr. 26, 2000)
Trandal	US 2003/0081752 A1	May 1, 2003 (filed Nov. 1, 2001)

The Examiner's Official Notice.

The rejections as presented by the Examiner are as follows:

1. Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Olshansky, Trandal, and Patel.

2. Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Olshansky, Trandal, Chang, and Patel.

3. Claims 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Olshansky, Trandal, Chang, Patel, and the Official Notice taken by the Examiner.

Rather than reiterate the opposing arguments, reference is made to the Briefs and the Answer for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered (37 C.F.R. § 41.37(c)(1)(vii)).

OPINION

With respect to the rejection of claims 1-8, the focus of Appellants' arguments is that Olshansky relates to a system that enables a single function in response to authentication of a person and involves no other network-related functions (Br. 6). Appellants further argue that the generation of a bill or alarm and pushing advertisements to subscribers of Olshansky do not constitute at least one other network-related function, as recited in claim 1 (*Id.*). Appellants assert that the instant Specification describes information delivery and trading of financial interests as the claimed network-related functions (Specification 13) whereas voice mail and conference calls are described as voice communication services (Specification 16-18), as recited in claim 1 (Br. 8).

The Examiner responds by stating that the claims merely recite participating in a "network-related function" and voice communication without requiring that the function be related to the telephone service (Answer 12). Relying on Appellants identifying information delivery as a network-related function (Br. 8), the Examiner concludes that providing billing information in Olshansky is a kind of information delivery and reads on the claimed "network-related function" (Answer 12).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596,

1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *See also In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such evidence is required in order to establish a prima facie case. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

In determining the subject matter encompassed by claims 1 and 3, we agree with the Examiner that the claim merely requires the enabled computer terminal to access or participate in the performance of at least one network-related function and voice communication. However, the claimed features do not specify any particular function related to the network, nor may such limitation be imported from the Specification into the claims. As such, we remain unconvinced by Appellants' arguments (Reply Br. 4) that the claim

necessarily requires those functions mentioned in the Specification which make it different from the billing and advertising services in Olshansky.

As pointed out by the Examiner, Olshansky discloses a system for callers to obtain telephone services at a subsidized rate (col. 2, ll. 4-13) after the caller is authenticated and receives an advertisement (col. 2, ll. 16-21). Olshansky further teaches that an accounting unit tracks the duration and bandwidth of the call (col. 3, ll. 10-20) to be displayed on the Graphical User Interface depicted in Figure 3. The functional buttons depicted in Figure 3 show that the user may use memory pad 322 or numerical keypad 324 for placing a call and participating in voice communication (col. 5, ll. 5-10). Another button available to the user is disclosed as billing information button 326 which may include the usage, duration, and the present cost of the call to the user (col. 5, ll. 11-18). Therefore, Olshansky does disclose the claimed network-related function, as the presented billing information, in addition to voice communication. We note that contrary to Appellants' assertion that billing and advertisement are not separate services (Reply Br. 4), the advertisement presented to the caller in Olshansky merely determines the billing rate and has nothing to do with the voice communication or the billing information displayed to the user.

Appellants further argue that Trandal and Patel do not disclose anything related to the missing features in Olshansky and conclude that the deficiencies of the primary reference remains uncured (Br. 8-9). As Appellants provide no specific arguments with respect to the rejection of

claims over Trandal and Patel in combination with Olshansky, as discussed above, we find the Examiner's reasoning for the combination to be convincing. We therefore sustain the 35 U.S.C. § 103 rejection of claims 1 and 3, as well as claims 4-8, argued (Br. 11) as falling with their base claims.

Regarding claim 2, Appellants assert that the combination of the references fails to teach or suggest the enabling voice communication to and from each terminal for which a sensed finger-image was authenticated (Br. 11). We agree with the Examiner (Answer 13-14) that the claim does not require that the users at both sides of a voice communication must be authenticated and instead, recites that voice communication be enabled for any terminal for which a sensed finger-image is authenticated (Answer 14). In that regard, the combination of Olshansky, Trandal, and Patel does suggest the recited enabling means since the voice communication and the network-related function may be performed even if only one terminal is authenticated. Accordingly, we sustain the 35 U.S.C. § 103 rejection of claim 2.

Regarding claim 9, Appellants assert that adding Chang to the combination does not provide for the features related to enabling one authenticated terminal to participate in voice communication over the network with another terminal that also has been authenticated (Br. 10). In response, the Examiner points out that the arguments made above with respect to claims 1 and 3 are not quite relevant to claim 9 since claim 9 does not require both voice communication and network-related function to be

performed by the authenticated user. However, we find that similarly to claim 2, claim 9 does not require that users on both sides of a voice communication must be authenticated and instead, recites that voice communication be enabled for any terminal for which a sensed finger-image is authenticated. Therefore, based on the teachings of Olshansky, Trandal, and Patel outlined *supra*, and to the extent claimed, we find ourselves persuaded by the Examiner's position that the voice communication is available for each computer terminal for which a finger-image war authenticated. Therefore, we sustain the 35 U.S.C. § 103 rejection of claim 9, as well as dependent claims 10-12, which are argued (Br. 11) to fall with their base claim.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-12 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

tdl/ce

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